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TO:	Examiner Mark A. Fadok	FROM:	Benjamin S. Withrow, Esq.
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RE:	Reply Brief	YOUR REFERENCE NUMBER:	09/802,634

☐ URGENT ☐ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY ☐ ORIGINAL TO FOLLOW

NOTES/COMMENTS:

Please find attached the following item:

- 1) Reply Brief (4 pages).

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shimon S. Shmueli et al.

Serial No. 09/802,634

Filed: 03/09/2001

For: **ACCOUNT PORTABILITY FOR COMPUTING**

Examiner: Fadok, Mark A.

Art Unit: 3625

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

The present **REPLY BRIEF** is filed to address issues raised in the Examiner's Answer mailed March 24, 2005. If any fees are required in association with this Reply Brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

REPLY BRIEF**Introduction**

Appellant appreciates the withdrawal of the objection to claims 14 and 19. However, the Patent Office's arguments about the teachings of O'Leary still do not teach the financial information stored on the portable device. Appellant further objects to the introduction of Turgeon advanced by the Patent Office in the Examiner's Answer. The introduction of Turgeon at this late date constitutes an impermissible shift in the Patent Office's position, needlessly cluttering the issues before the Board. Even if Turgeon is properly before the Board, the Patent Office has not established a proper motivation for its use in the rejection, and the rejection still fails to establish *prima facie* obviousness.

Argument

The Patent Office repeats its rejection from the Office Action of August 26, 2004. As Appellant's Appeal Brief adequately addresses the issues raised therein, Appellant focuses this Reply Brief on the Response to Arguments section raised in paragraph (11) of the Examiner's Answer.

The Patent Office initially directs attention to *O'Leary*, col. 9, lines 15-20, alleging "the contents of the wallet, that includes financial information, is downloaded to a variety of portable devices such as PDA's [sic] and cellular telephones."¹ However, this assertion ignores the thin wallet nature of *O'Leary* discussed at length in the Appeal Brief. In fact, the cited passage makes no indication that the portion of the Wallet downloaded to PDAs contains any financial information. In full, the passage states: "[s]ome functionality of the Wallet 215 can be operated on the workstation 200 itself, without the requirement of attachment to the Internet. In addition to PC-based access as described above, the Wallet 215 can be downloaded to various non-PC devices such as PDAs, cellular telephones, and interactive TV's [sic]."² But as previously pointed out, the immediately preceding passage indicates that the Wallet 215 is a thin wallet and the majority of the software and databases comprising the Wallet 215 resides on a host web server. *O'Leary*, col. 9, lines 10-15. Thus, when *O'Leary*, col. 9, lines 15-20 indicates that the wallet is downloaded to the PDA, this indicates that the thin wallet is downloaded to the PDA, and the majority of the software and databases remain on the web server, including the financial information. As already indicated in the Appeal Brief, the Patent Office's focus on this isolated portion of *O'Leary* constitutes an impermissible extraction of an element out of context and ignores the other relevant portions of *O'Leary*. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

The Patent Office supplements its position by stating "Further, TURGEON is added to the previous rejection to show an example of smart card technology used for storing financial information (see claim 1)."³ Appellant respectfully traverses the inclusion of Turgeon at this late date. The MPEP § 1208 states:

It also frequently happens that an examiner will state a position in the answer in a manner that represents a shift from the position stated in the final rejection without indicating that the last stated position supersedes the former. Such a situation confuses the issue and likewise poses difficulties for the Board since it is not clear exactly what the examiner's ultimate position is.⁴

Appellant respectfully maintains that the addition of Turgeon is a new rejection. As Turgeon was published on January 16, 2003, before the first Office Action of March 5, 2004, there is no

¹ Examiner's Answer of March 24, 2005, page 9, lines 14-16.

² *O'Leary*, col. 9, lines 15-20.

³ Examiner's Answer of March 24, 2005, page 9, lines 18-20 (emphasis in original).

⁴ MPEP § 1208, p. 1200-17, August 2001 edition available at www.uspto.gov

reason why Turgeon should not have been cited prior to the appeal if it was necessary to establish obviousness. Rather than introduce a new basis for rejection in the Examiner's Answer, the Patent Office should have re-opened prosecution and issued a new rejection based on the use of Turgeon advanced in the Examiner's Answer. Appellant notes that MPEP § 1208 also indicates that a new ground of rejection is no longer permitted in an Examiner's Answer. Since the addition of Turgeon constitutes a new ground of rejection, the use of Turgeon is improper. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

Even if the late addition is proper, the Patent Office has not complied with the rules set forth by the Federal Circuit for combining references in an obviousness analysis. Specifically, the Patent Office has not advanced any motivation to combine the teachings of Turgeon with O'Leary, Rallis, and de la Huerga. The Patent Office has not provided a motivation to combine the references, and the Patent Office has also not set forth actual evidence to support the motivation as required. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Still further, as explained in the Appeal Brief, the Patent Office is not free to ignore portions of the various references in a combination. Thus, the Patent Office must reconcile the thin wallet nature of O'Leary with the teachings of Turgeon and find some proof that it would be obvious to change O'Leary's thin wallet. Since the Patent Office has done none of these things, the Patent Office's implicit rejection of the claims based on Turgeon does not satisfy the procedural burdens set forth to establish obviousness. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

Conclusion

The Patent Office's efforts to show the financial information stored on the portable device fail in view of O'Leary's thin wallet model. Likewise, the use of Turgeon to supplement the failings of O'Leary is improper. Even if Turgeon is properly before the Board, the Patent Office has not justified its use with the guidelines set forth in the MPEP or by the Federal Circuit. As such, the Patent Office has not established obviousness, and Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

Respectfully submitted,

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<p align="center">CERTIFICATE OF TRANSMISSION</p> <p>I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW TO:</p> <p>Examiner: <u>Fadok, Mark A.</u> Art Unit: <u>3625</u> Fax: <u>703-872-9306</u></p> <p><u>REBECCA ROCKS</u> Name of Sender</p> <p><u>Rebecca L. Rocks</u> Signature</p> <p><u>5-18-05</u> Date of Transmission</p>
